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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/107,971

06/30/1998

ANDREW S VAN LUCHENE

98-024

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12/18/2008

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/107,971	Applicant(s) VAN LUCHENE, ANDREW S	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is supplemental to the action mailed 10/28/2008, more clearly stating the status of the appeal and applicant's options.

1. In view of the appeal brief filed on 6/2/2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-19, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

4. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Examiner recommends including language that specifies a programmed computer is responsible for carrying out the method steps (i.e. not merely a nominal recitation of a computer accepting input or performing output, but rather a computer performing the essential calculations, determinations, algorithms, etc.).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been

obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6887153, claims 1-11 of U.S. Patent No. 6582304, and claims 1-12 of U.S. Patent No. 6267670. Although the conflicting claims are not identical, they are not patentably distinct from each other because associating ticket numbers for a lottery ticket and identifying that ticket with a ticket record was obvious at the time, as well as allocating a portion of a lottery ticket is taken to inherently include allocation of the portion to an available, unallocated portion of the lottery ticket.

7. Claims 1-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-22 of copending Application No. 10/457101 and over claims 2-5, 7-10, 14-16, 18-20, 37-52. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3, 7-10, 15-18, 20, 21, 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts (US5772510).

10. Regarding claims 1, 3, 16, 20, 21, 26, 27, Roberts teaches a lottery ticket point of sale device; see figure 7. The device has a mechanism to accept currency at items 48 and 50. Roberts teaches "[t]he payment indication circuit 50 provides an indication of the amount of money inserted into slot 48 by the purchaser. If the proper price has been paid, printer 19 prints the ticket completion information 20a, 20b..." [column 6: lines 60-65]. The payment indication circuit is taken to perform the claimed "determining a monetary value" step. Further, we consider the output of the ticket to the user to be the claimed step of "allocating a portion of a ticket". The electronic ticket (record) is associated with a collection of numbers as is customary for lottery tickets. Examiner considers the scope of the claimed "fractional lottery ticket value" to include the whole value of the ticket, as 1/1 and 2/2, 10/10, etc. are indeed fractions. Thus delivering a ticket to the purchaser in response to receiving the proper fee meets the claimed "outputting the ticket numbers and a fractional lottery ticket value". Further, Roberts' teaches that the paper ticket includes a ticket identifier (unique barcode 16 and 20) along with information identifying the value of the ticket full

portion (see information 20b, which identifies \$1.00), which we consider to meet the claimed outputting a ticket identifier portion.

11. Regarding claim 7, once the ticket record is created, but charging price for it, Roberts provides increasing a total value of the ticket in accordance with the purchase price.

12. Regarding claims 8-10, the tabulating the total sale made by the register of Roberts for all of the tickets sold in a transaction can be taken to represent “adjusting an amount” to round up. Further, any ticket has a price associated therewith which can be taken to meet “an amount to round up”. Choosing from unsold lottery tickets meets the language of selecting from the set of (unsold) records; this selection will also represent an available, minimum amount to round up (the purchase price).

13. Regarding claim 15, 24, 25, the prize won for a winning ticket is taken to provide a prize value based on the lottery ticket value (as well as the “fractional” lottery ticket value).

14. Regarding claims 17, 18, the system of Roberts is taken to inherently select/acquire/assign lottery tickets only for an upcoming drawing. Therefore Roberts acquires tickets in predefined periods before each drawing.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts.**

17. Regarding claims 4-6, Roberts teaches selection of the ticket information randomly or by accessing a file (taken to provide "receiving a signal" [col 4:43-46]. It would have been obvious to one of ordinary skill at the time of the invention to have selected a ticket record randomly so as to offer the customer a quick random entry, or to let the customer choose his own numbers and searched any available ticket records to accommodate the request.

18. **Claims 2, 11-14, 19, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts as above further in view of Herman** (Herman, Ken, "Auchan cashes in on Lottery", 7/1/1992, Houston Post, pg A15.)

19. Regarding claims 2, 11, 14, 22, 23, Herman teaches offering lottery tickets for sale as part of the customer's change due. It would have been obvious to one of ordinary skill at the time of the invention to have offered lottery sales as part of customer's change due.

20. Regarding claims 12, 13, 19, Official Notice is taken that it is well known to round change due amounts up or down so as to avoid exchange pennies for example and it would have been obvious to one of ordinary skill at the time of the invention to have done so with that of Roberts and Herman. Further, a rounding operation performed in \$0.50 (either down or up) results in the same \$0.50 value.

21. **Claims 1, 3-10, 15-18, 20, 21, 24-27 are ALTERNATIVELY rejected under 35 U.S.C. 103(a) as being unpatentable over applicant admitted prior art in view of Roberts (US5772510) as applied above.**

22. Roberts is analyzed as done above. Applicant admits the well known lottery systems (such as in Germany) where players may purchase fractions (such as $\frac{1}{2}$, $\frac{1}{4}$ shares) of a full

lottery ticket and whereby the winners of such tickets receives respective shares ($1/2$, $1/4$) of the prize [spec page 3]. Applicant does not speak of how the management of such fractional tickets are managed, yet given Roberts's electronic management of lottery distribution and prize redemption/authentication, it would have been obvious to one of ordinary skill at the time of the invention to have electronically managed such a lottery system that included fractional amounts by stored ticket identifiers as well as fraction identifiers so that users can confidently purchase fractions of tickets and win respective fractions of the winning ticket prizes. It would have been obvious to one of ordinary skill at the time of the invention to assign fractions of tickets from tickets having unassigned portions, so as to avoid for example three purchasers of $1/2$ tickets from sharing a single ticket.

23. Regarding claim 10, it would have been obvious to one of ordinary skill at the time of the invention to have managed the ticket inventory whereby fractions of tickets are associated with tickets having available fractions rather than assigning all fractions to new, fully unallocated tickets. This would avoid an excess of needless tickets all having only a small fraction allocated. This is similar to a pizza shop selling slices of pizzas whereby steps are taken to minimize the number of pizzas with only a few slices removed from them.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc